

REMARKS

Reconsideration of this application in light of the present amendment and remarks is respectfully requested.

Claims 1-2, 4-9, 11-13, 15-17, 19 and 21-27 have been rejected.

Claims 3, 4, 9, 10, 14, 18, 20, 21 and 23-26 were previously canceled.

No claims have been amended.

Claims 1-2, 5-8, 11-13, 15-17, 19, 22 and 27 are pending in this application.

Claims 1-2, 5-8, 11-13, 15-17, 19, 22 and 27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (U.S. Patent No. 6,183,366 hereinafter Goldberg) in view of Hall et al. (U.S. Patent No. 6,026,375 hereinafter Hall). This rejection is respectfully traversed.

Regarding independent claim 1, the Examiner admits that neither Goldberg nor Hall disclose the provision for a quota within a predetermined time period and terminating advertisements upon reaching the quota. The Examiner goes on to state that these two elements are obvious to a person of ordinary skill in the art because free Internet access to users is presently subsidized by the download of advertisements and the use of quotas could be used to determine the threshold for free Internet access.

Applicants are willing to stipulate that there are business cases where free Internet access is subsidized by advertisements. However, there are presently no known provisions in such cases for the termination of advertisements upon reaching a quota. In fact, the present day Internet experience teaches away from applicants' invention in that advertisements never reach a threshold and are ever present.

Applicants also submit that the Examiner has misunderstood applicants' invention where, instead of terminating free Internet access upon reaching an advertisement quota (i.e. threshold) as stated, applicants' invention terminates the advertisements while continuing Internet access, as recited in the independent claim 1. In particular, the Examiner's interpretation for terminating free Internet access upon reaching an advertisement quota is no different from the present Internet experience wherein advertisements are stopped (obviously) when a user terminates Internet access, the difference only being cause and effect, but having the same result. In contrast, applicants' invention provide a different business case wherein a Internet service

provider would provide an advantage for a user to use that particular access provider by the knowledge that advertisements will stop after reaching a quota whereinafter the user would have uninterrupted Internet access. In this way, the use of quotas would be much more likely to lure users to a service, in that, a user would be much likely to subscribe to a service if they knew they would not be subject to an endless barrage of advertising, but instead be subject to a fair portion of advertising in exchange for their patronage.

Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, all the claim limitations are not taught or suggested by the prior art. Thus, the cited references clearly fail to render obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the applicants' specification, it is a substantial benefit to use the claimed invention because it uses a quota to permit a user relief from relentless presentation of advertisements. The known art, for the reasons mentioned above, simply does not suggest the desirability of the claimed invention since it doesn't provide for the termination of advertisements while continuing Internet access.

Deficiencies of the cited references cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art), and in particular where the known art teaches away from applicants' invention as explained above.

Claims 2 and 12 are dependent on claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above.

Regarding independent claims 13 and 27, the above comments with respect to claim 1 also apply to claim 13. In addition, the cited art teaches a system to check whether advertisements are presented in a destination device, but does not provide a definitive technique to guarantee that a user actually observes the advertisement. Applicants solve this problem by

requiring a two-way interaction where the end user actually acknowledges the receipt of the advertisement. The inclusion of manual feedback is a significant difference from the cited art. Therefore, applicants' invention of claim 13 solves a problem that is not address by the cited art.

Again, the Examiner goes on to state that a provision to have a user acknowledge an advertisement would be obvious to one skilled in the art. However, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, all the claim limitations are not taught or suggested by the prior art. Thus, the cited references clearly fail to render obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the applicants' specification, there is a benefit to a service provider to supply definitive evidence that an advertisement has been actually viewed by have a viewer manually acknowledge same. The known art, for the reasons mentioned above, simply does not suggest the desirability of providing manual interaction, but instead providing a convoluted automatic process that only proves the advertisement was presented, but does not guarantee that the advertisement was reviewed.

Deficiencies of the cited references cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art), and in particular where the known art teaches away from applicants' invention as explained above.

Claims 5, 6 and 11 are dependent on claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above.

Claim 17, 19 and 22 are dependent on claim 13, and therefore include all of the recitations of claim 13, which are not disclosed or suggested by the references, as described above.

Further, in regard to independent claim 27, the office action does not specifically address the added limitations in claim 27 but simply refers to the discussion relating to claims 12 and 13. Claim 27, however, recites that the step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device. None of the cited references or known art discuss or make any mention of vehicle sensors much less advertisements based upon such vehicle sensors. The applicant respectfully requests for identification of where this feature is located in the cited references.

Accordingly, it is respectfully submitted that this rejection has been overcome.

Claims 7, 8, 15 and 17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg in view of Hall as applied to claims 1, 2, 5, 6, 11-13, 17, 19, 22 and 27 above, and further in view of Titmuss et al. (WO 98/47295 hereinafter Titmuss). This rejection is respectfully traversed.

Claims 7 and 8 are dependent on claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above.

Claim 15 and 17 are dependent on claim 13, and therefore include all of the recitations of claim 13, which are not disclosed or suggested by the references, as described above.

Accordingly, it is respectfully submitted that this rejection has been overcome.

Applicants respectfully submit that the prior art references, in combination or alone, fail to teach or suggest all of applicants' claimed limitations, as required for a 35 USC §103(a) rejection. Namely, with regard to claims 1, 13 and 27 (and their dependent claims), none of the references teach at least the steps of providing a quota of advertising, determining whether advertisements actually have been delivered, or terminating advertisements upon reaching a quota. With regard to claim 13, none of the references teaches at least the step of requiring user interaction to determine whether an advertisement was reviewed to be and considered an advertisement that was provided in lieu of receiving compensation for the service. Additionally, with respect to independent claim 27, none of the references teaches the additional step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device.

Therefore, the teachings of the cited art, in combination or alone, fail to teach or even suggest the novel and unobvious recitations of the above claims. For the foregoing reasons, applicants believe that the claims, as amended, are patentably distinct and non-obvious from all of the references of record, whether taken alone or in combination.

Accordingly, it is respectfully submitted that this rejection has been overcome.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

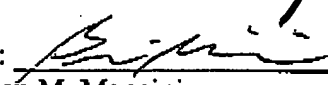
Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

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Respectfully submitted,
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